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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,930	09/04/2003	Geoffrey B. Rhoads	P0877	8366
23735 7590 06/19/2009 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
EXAMINER				
PERUNGAVOOR, VENKATANARAY				
ART UNIT		PAPER NUMBER		
2432				
MAIL DATE		DELIVERY MODE		
06/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/656,930

**Applicant(s)**

RHOADS ET AL.

**Examiner**

Venkat Perungavoor

**Art Unit**

2432

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-12, and 14-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-12, 14-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 7-12, 15-20 of copending Application No. 10/326575. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application deals with checking authenticity of a digital representation of object by comparing the authentication in watermark with the authentication stored in database,

while '575 uses the same method to authenticate a document. That is, the instant application is a broader version of '575 and thus not patentably different.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10/656930

10/326575

Claim 1,3-11

Claim 1,8,16

a storage system in which stored second authentication information is associated with stored reference codes; and	a database for storing digital watermark information related to a personal document;
<p>a processor which receives the digital representation and a reference code associated therewith, the reference code is included in the digital representation, the processor including:</p> <p>an authentication information reader, and the processor: i) employing the reference code to retrieve the second authentication information associated therewith from the storage system, ii) employing the authentication information reader to recover the embedded first authentication information, and iii) employing recovered first authentication information and the second authentication information to determine authenticity of the digital representation.</p>	<p>said personal document including a readable authentic image in which a digital watermark comprising additional information is embedded; a read means for reading at least said authentic image and machine readable information from said personal document, the machine readable information being used to obtain the digital watermark information from the database automatically; a watermark information inquiring means for checking said additional information embedded in said authentic image; and a watermark information authentication means for judging whether said additional information from said personal document is related to said watermark information stored in said database.</p>

Claim 12, 14-21, 15, 17

Claim 1,8,16

an analog form converter that receives the analog form and makes a digital representation of at least the steganographically embedded first authentication information	generating means for generating an identifier unique to a personal document; a watermark information generating means for generating digital watermark information corresponding to said identifier
a communication system	<i>Communication system is inherent in a network-based database system.</i>
the analog form converter employing the communications system to send the digital representation and a reference code to a verification system that employs the reference code and the steganographically embedded first authentication information to determine whether the analog form is authentic and to receive a notification whether the analog form is authentic from the verification system, wherein the reference code is sent in association with but not as part of the digital representation.	a database for storing said identifier of said personal document and said digital watermark information relative to said identifier in relation to each other; a watermark information registering means for storing said identifier generated by said identifier generating means and said digital watermark information generated by said watermark information generating means in said database; an image input means for inputting a raw authentic image; a watermark-embedded image forming means for forming a watermark-embedded authentic image in which said digital watermark comprising additional information is embedded in the raw authentic image to produce said authentic image input by said image input means; and a personal document issuing means for producing a personal document that readably carries said authentic image generated by said watermark-embedded image forming means and the identifier, the identifier being readable from the personal document to obtain the digital watermark information from the database.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-12, and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5604802 to Holloway.

Regarding Claim 1, 20, 11, 18, Holloway discloses the storage system which stores the second authentication information see Col 2 Ln 19-26(where the characteristic data is centrally held, i.e. storage system); a processor having an information reader see Fig. 3 item 515; and processor to retrieve second authentication information see Fig.1 item 503c and recover the first authentication information and compare with second authentication information to determine authenticity see Col 3 Ln 2-8 ; the embedding of first information see Abstract.

Regarding Claim 3, 15, Holloway discloses the storage system which stores the second authentication information see Fig. 1 item 519; a processor having an information reader see Fig. 1 item 517a; and processor to retrieve second authentication information see Fig. 1 item 513b and recover the first authentication information and compare with second authentication information to determine authenticity see Fig. 1 item 508; the embedding of first information see Abstract.

Regarding Claim 4, Holloway discloses the second authentication is based on semantic information contained in the image see Col 3 Ln 29-37; the authentication information reader includes a semantic information reader and authentication information maker see Col 5 Ln 39-44.

Regarding Claim 5, Holloway discloses the authenticity of the code being verified to the source see Col 2 Ln 34-40.

Regarding Claim 6, Holloway discloses the computer analyzing signatures of photos see Col 5 Ln 45-55 .

Regarding Claim 7, Holloway discloses the source associates the code with digital representation see Col 6 Ln 19-23.

Regarding Claim 8, 14, Holloway discloses the number being inputted by the user see Col 2 Ln 34-40.

Regarding Claim 10, Holloway discloses the plurality of devices and routing codes see Col 6 Ln 19-31

Regarding Claim 12, 14, 17, Holloway discloses the digitalizing of photos see Col 5 Ln 39-44; further discloses the storage system which stores the second authentication

information see Fig. 1 item 519; a processor having an information reader see Fig. 1 item 517a; and processor to retrieve second authentication information see Fig. 1 item 513b and read the first authentication information and compare with second authentication information to determine authenticity see Fig. 1 item 508; the steganographically embedding of first information see Abstract.

Regarding Claim 19, Holloway discloses the photo ID being digitalized see Col 5 Ln 33-44.

Regarding Claim 21, Holloway discloses the indication of authenticity of the digital representation see Fig. 1 item 508.

Regarding Claim 9, Holloway discloses the authentication of read information see Abstract and analog form containing a security pattern and associating the pattern with digital representation see Col 6 Ln 19-23.

Regarding Claim 16, Holloway disclose that the verification system employs the reference code to locate second authentication information and additionally uses the second authentication information to determine whether the digital representation is authentic see Fig. 1 item 512b.

### ***Conclusion***



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkat Perungavoor whose telephone number is (571)272-7213. The examiner can normally be reached on 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

/V. P./  
Examiner, Art Unit 2432  
June 18, 2009  
/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434